

REMARKS

Claims 1-37 are pending. By this Amendment, claims 1, 21 and 22 are amended. Reconsideration in view of the amendments and following remarks is respectfully requested.

Claims 21, 24 and 25 were rejected under 35 U.S.C. § 112, second paragraph. The claims have been amended to obviate the rejection.

Reconsideration and withdrawal of the rejection under 35 U.S.C. § 112, second paragraph are respectfully requested.

Claims 1-21 and 26-37 were rejected under 35 U.S.C. § 103(a) over Wang et al. (U.S. Patent 5,461,570). The rejection is respectfully traversed.

MPEP § 2143 states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations."

Wang et al. disclose a computer system for quality control correlations, particularly with respect to an automated production line for producing contact lenses. Wang et al. provide a plurality of process controllers for controlling one or more process stations. A polling device polls each process controller periodically to acquire process control data. Each contact lens produced is inspected by an automated lens inspection device that generates inspection data. The inspection data is correlated to the process control data to optimize process parameters used in the production of contact lenses.

Wang et al. do not disclose or suggest any of the features of claim 1. Wang et al. do not disclose or suggest generating an auto-configuration script for executing an auto-configuration program, wherein said auto-configuration script activates default values for input to said auto-configuration program. As discussed above, Wang et al. periodically poll the process controllers to acquire process control data, Wang et al. do not activate default values for input into an auto-configuration program.

Wang et al. do not disclose or suggest executing an auto-configuration script to generate an enabled parameter file output from said auto-configuration program, wherein the enabled parameter file identifies parameters for statistical process control (SPC) chart generation. As recited in claim 1, an enabled parameter is an identified parameter for which a statistical process control (SPC) chart is generated. Wang et al. do not execute an auto-configuration script, nor do Wang et al. generate an enabled parameter file output from the

auto-configuration program. Moreover, Wang et al. do not identify parameters for statistical process control (SPC) chart generation. Wang et al. merely correlate process control data from various process controllers with visual inspection data of the produced product to optimize the process control parameters.

As Wang et al. do not disclose or suggest all the features of claim 1, Wang et al. do not present a *prima facie* case of obviousness against claim 1.

With respect to the Examiner's determination that "one of ordinary skill in the art would be able to modify the various parameters taught by Wang in order to create a script that gives the specific parameters required for the claimed environment" and "it is capable to perform such a function in any given environment or process, as defined by the user or programmer," Applicants respectfully disagree. As discussed above, Wang et al. optimize the process parameters based on the visual inspection data obtained from the automated lens inspection device. Wang et al. clearly do not disclose or suggest to one of ordinary skill in the art a script that activates default values for input into an auto-configuration program, or executing the script to generate an enabled parameter file output from the program, wherein the enabled parameter file identifies parameters for SPC chart generation. Therefore, one of ordinary skill in the art would not have, and could not have, modified the various parameters taught by Wang et al. to create a script.

It is further respectfully noted that MPEP § 2143.01 III states: "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." (Underlining emphasis in original.) MPEP § 2143.01 III further states: "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.'"

It is respectfully submitted that the Examiner has not provided any suggestion or motivation for the conclusion that it would have been obvious to modify Wang et al. It is also respectfully submitted that the Examiner's determination that the method of Wang et al. is capable of being performed in any given environment or process is incorrect, but irrelevant. As discussed above, the method of Wang et al. requires visual inspection of the product that is produced. Such a method would not be capable of use in, for example, a plasma chamber in which a semiconductor substrate is being processed. The Examiner's determination is irrelevant to the determination of obviousness, however, as Wang et al. do not disclose or suggest the method of claim 1. Therefore, regardless of which environment or process the method of Wang et al. is used, such use would not anticipate or render obvious claim 1.

The Examiner is respectfully requested to clarify his conclusion that the method in Wang is “inherently capable of performing such a function.” MPEP § 2112.02 states: “Under the principles of inherency, if a prior art device, in its normal and usual operation, would necessarily perform the method claimed, then the method claimed will be considered to be anticipated by the prior art device. When the prior art device is the same as a device described in the specification for carrying out the claimed method, it can be assumed the device will inherently perform the claimed process.”

The system disclosed by Wang et al. is not the same as the system disclosed in the application. Accordingly, the system of Wang et al. can not be “inherently capable” of performing the method of claim 1. It is also respectfully noted that the Examiner has not provided any basis in fact and/or technical reasoning, as required by MPEP § 2112, to support the determination that the method in Wang et al. is “inherently capable” of performing the method of claim 1.

Claims 2-21 and 26-37 recite additional features of the invention and are allowable for the reasons discussed above with respect to claim 1, and for the additional features recited therein.

Reconsideration and withdrawal of the rejection of claims 1-21 and 26-37 over Wang et al. are respectfully requested.

Claims 1, 3, 4, 6, 9, 11 and 22-25 were rejected under 35 U.S.C. § 103(a) over Mangrulkar (U.S. Patent 5,586,041). The rejection is respectfully traversed.

Mangrulkar discloses a method of monitoring the operation of a machine having a traversing tool. The machine is operated to produce a predetermined number of production parts. A set of production process signatures are collected for each of the predetermined number of production parts. A plurality of features are defined for each set of signatures. Each feature represents a parameter extracted through direct measurement or extracted through some form of computation. Feature values are extracted from each set of signatures in real time to obtain a corresponding set of production feature values. Each set of production feature values is compared to predetermined operating limits within which the process is in control or producing acceptable parts.

Mangrulkar disclose in column 2, lines 16-19, that because many factors affect process control and part quality, it is desirable to monitor process operation utilizing a plurality of variables which can be extracted from the press signature in real time. Mangrulkar further discloses in column 2, lines 33-36, that the objective of his invention is to

provide a method for real time statistical process monitoring of a machine operation utilizing user-specified features extracted from a machine cycle signature.

Mangrulkar does not disclose or suggest an auto-configuration script for executing an auto-configuration program. Mangrulkar discloses collecting a set of production process signatures for each predetermined part produced and defining feature values for each set of signatures, *i.e.*, operating the machine to obtain the defined feature values. Mangrulkar does not disclose or suggest executing an auto-configuration script to generate an enabled parameter file output that identifies parameters for SPC chart generation. Mangrulkar discloses extracting feature values from the production process signatures in real time to obtain production feature values, and then comparing the production feature values to predetermined operating limits.

With respect to the Examiner's determinations on page 6, paragraph number 9, that one of ordinary skill in the art "would be able to modify," and/or the method of Mangrulkar is "capable" of, or "inherently capable of," performing the method of claim 1, it is respectfully submitted that the Examiner's determinations fail to establish a *prima facie* case of obviousness for the reasons discussed above.

Claims 3, 4, 6, 9, 11 and 22-25 recite additional features of the invention and are allowable for the same reasons discussed above with respect to claim 1 and for the additional features recited therein.

Reconsideration and withdrawal of the rejection over Mangrulkar are respectfully requested.

In view of the above amendments and remarks, Applicants respectfully submit that all the claims are allowable and that the entire application is in condition for allowance.

Should the Examiner believe that anything further is desirable to place the application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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